No. 94-1531

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1995

NOVOPHARM, INC. and NOVOPHARM LTD.,

Petitioners,

—v.—

BURROUGHS WELLCOME CO.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

RESPONDENT'S SUPPLEMENTAL BRIEF IN OPPOSITION

E. Anthony Figg
Counsel of Record
Steven Lieberman
Joseph A. Hynds
ROTHWELL, FIGG, ERNST & KURZ
555 Thirteenth Street, N.W.
Washington, D.C. 20004
(202) 783-6040

Thomas F. Curnin
Laura Mezey
Daniel L. Cantor
Michael B. Weiss
CAHILL GORDON & REINDEL
(A Partnership Including A
Professional Corporation)
80 Pine Street
New York, New York 10005
(212) 701-3000

Of Counsel:

Paul A. Holcombe, Jr.
Susan S. Dunn
GLAXO WELLCOME INC.
Five Moore Drive
Research Triangle Park, N.C.
(919) 315-3000

Counsel for Respondent
Burroughs Wellcome Co.

7 pp

RULE 29. 6 STATEMENT

Respondent Burroughs Wellcome Co. is now known as Glaxo Wellcome Inc., a North Carolina corporation. Glaxo Wellcome Inc. is wholly owned by Glaxo Wellcome Americas Inc., which is wholly owned by Glaxo Group Ltd., which is wholly owned by Glaxo Wellcome plc. All of the subsidiaries of Glaxo Wellcome Inc. are wholly owned. For ease of reference, respondent will continue to refer to itself as Burroughs Wellcome Co.

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Respondent Burroughs Wellcome Co. ("BW Co.") respectfully submits this supplemental brief, pursuant to S. Ct. R. 15.8, in order to address the inaccuracies contained within Novopharm, Inc.'s and Novopharm Ltd.'s (collectively "Novopharm") Reply to Brief of the United States as Amicus Curiae.[1]

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[1] References to "Rep. U.S. Br. __" are to Petitioners' Reply to Brief of the United States as Amicus Curiae. References to "U.S. Br. __" are to the Brief for the United States as Amicus Curiae. References to "Opp. __" are to Respondent's Brief in Opposition. References to "Pet. __" and "Pet. App. __" are to the Petition for Writ of Certiorari and the Appendix thereto, respectively.

DISCUSSION

The Solicitor General, responding to this Court's order inviting him to express the views of the United States, heard interested parties, conducted its own legal and factual review and concluded that Novopharm's petition for certiorari is without merit. U.S. Br. 19-20. In reply, Novopharm simply reiterates its earlier arguments of error.

I. AMICUS CORRECTLY RECOGNIZED THAT THIS COURT SHOULD NOT RE-EXAMINE THE FEDERAL CIRCUIT'S DE NOVO REVIEW OF THE DISTRICT COURT'S DECISION

Novopharm asserts that since Amicus allegedly "admits" that the Federal Circuit established new "controlling law", the appeals court was required to reverse the District Court and remand the case for a new trial based on this "new" law. Rep. U.S. Br. 2. This position is meritless. First, the cited language merely points out that whatever uncertainty may have existed concerned only the applicability of the doctrine of simultaneous conception and reduction to practice and did *not* apply to the well-established law of conception relied upon by the trial court and the Federal Circuit. U.S. Br. 14 & n.2. Novopharm's claim that the Federal Circuit, *sub silentio*, eviscerated the legal test for conception relied upon by the District Court simply misreads that court's opinion. Opp. 7-10.

Second, even if the Solictor General's brief implies some pre-existing uncertainty about the law of conception in speculative fields, it does not follow that the District Court's Rule 50(a) judgment is wrong as a matter of law. The Federal Circuit completely validated the District Court's interpretation of the law of conception—using the same cases to reach a virtually identical conclusion. *Compare* Pet. App. 11a-16a, 19a *with* Pet. App. 36a-37a. Furthermore, as the Solictor General recognizes, Novopharm's purported test for complete conception has never been the law and the "Federal Circuit's

reading [of the relevant cases] . . . is consistent with long-standing patent law principles". U.S. Br. 14.

Third, assuming *arquendo*, that the Federal Circuit's opinion represents a change in the "controlling law"—which it clearly does not—there was no obligation to order a remand. By *de novo* affirmation of the District Court's decision, the Federal Circuit held that the District Court reached the correct conclusion anyway. Novopharm can point to nothing which would warrant this Court to consider this case or mandate a remand.

Recognizing that its change in "controlling law" argument is insufficient to justify its certiorari petition, Novopharm asks this Court to assess facts, review evidence and conclude that the Federal Circuit erred "by ignoring critical facts in Novopharm's offer of proof, weighing evidence and ascribing credibility to witnesses, thereby improperly usurping the role of the jury." Rep. U.S. Br. 2. Yet, it is precisely that request which the Solictor General properly found objectionable. U.S. Br. 20 (*citing United States* v. *Johnston*, 268 U.S. 220, 227 (1925) ("We do not grant a certiorari to review evidence and discuss specific facts.")). Contrary to Novopharm's weak denials, granting their petition would require this Court to engage in yet a third review of the factual record and, by so doing, act contrary to established practice. Opp. 7-9.[2]

II. AMICUS CORRECTLY CONCLUDED THAT WHETHER OR NOT BRODER AND MITSUYA WERE MERE "PAIRS OF HANDS" IS IRRELEVANT

Novopharm asserts that once the Federal Circuit concluded that Drs. Broder and Mitsuya were more than mere "pairs of

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[2] In the instant case, such a factual review is especially unwarranted given the Federal Circuit's refusal to re-hear the case, even after Novopharm directed its attention to those facts it felt may have been overlooked by the Federal Circuit.

hands", it could not have concluded that the conception by the BW Co. scientists was complete. Rep. U.S. Br. 3-4. Novopharm raised precisely this same argument below and the Federal Circuit rejected it. Though Novopharm may take offense, the Solictor General correctly described this argument as a *non sequitur*.

The premise that Drs. Broder and Mitsuya may have performed tests which may have required more than ordinary skill *after* the date upon which the Federal Circuit says a complete conception existed cannot logically lead to the conclusion that the BW Co. conception was incomplete. The false issue of whether Drs. Broder and Mitsuya exercised "considerable skill" in the process of "simply confirming the operability of what the draft application disclosed" (Pet. App. 17a) is legally irrelevant to the Federal Circuit's decision. Having conceded that the February 6, 1985 draft application was enabling (Pet. App. 16a), Novopharm cannot collaterally attack the Federal Circuit's ruling by relying on *post*-conception testing.

CONCLUSION

For the foregoing reasons, for the reasons set forth in Respondent's Brief in Opposition and for the reasons set forth in the Brief for the United States as Amicus Curiae, the petition for a writ of certiorari should be denied.

January 1996

Respectfully submitted,

E. Anthony Figg
Counsel of Record
Steven Lieberman
Joseph A. Hynds
ROTHWELL, FIGG, ERNST & KURZ
555 Thirteenth Street, N.W.
Washington, D.C. 20004
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